

## **REMARKS**

This paper is filed in response to a Non-final Office Action dated July 21, 2010. Claims 1-22, 25, 26, and 36-50 were previously presented for Appeal, with Claims 5, 7, 14, 15, 17-22, 36-39, and 45-50 having been previously been withdrawn. In this paper, Claims 1, 6, and 44 have been amended, no claims have been canceled, and no new claims have been added. Accordingly, Claims 1-22, 25, 26, and 36-50 remain pending herein with Claims 5, 7, 14, 15, 17-22, 36-39, and 45-50 having been previously been withdrawn. No new matter has been added with these amendments.

### **Summary of the Office Action**

In the Office Action, Claims 1, 4, 6, 8-13, 25-26, and 40-44 were rejected under 35 U.S.C. § 102(e) as being anticipated by Popov et al. (U.S. Patent No. 7,422,572). Claims 2 and 3 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Popov in view of Roth (U.S. Patent No. 5,626,598). Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Popov. For at least the reasons discussed herein, Applicant respectfully traverses these rejections.

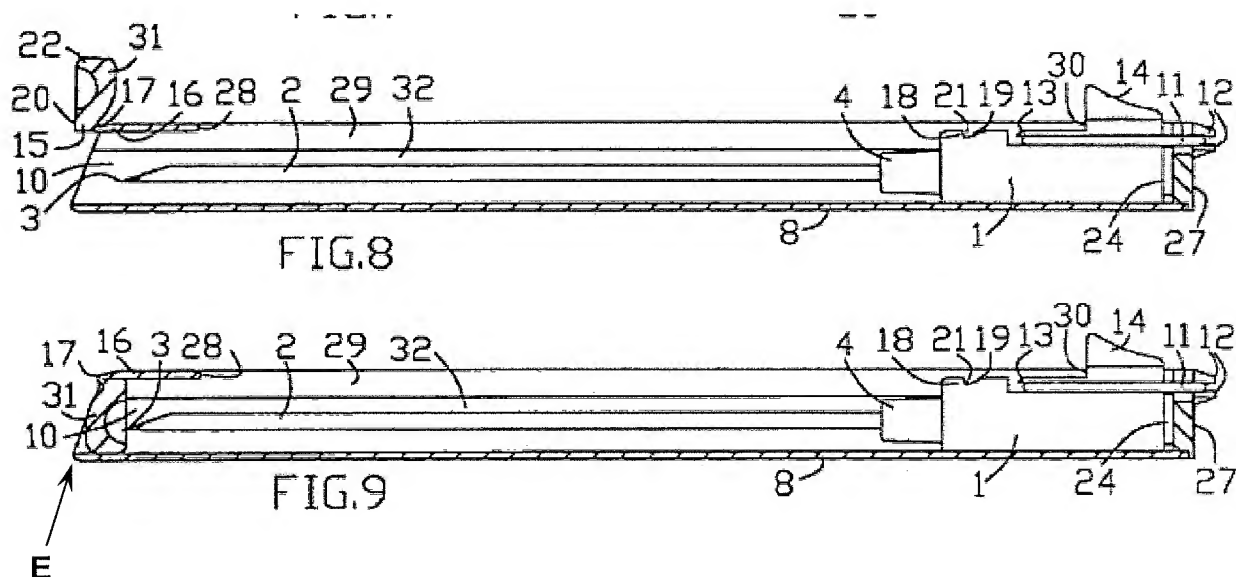
### **Popov Fails to Disclose the Recited Subject Matter.**

As noted above, independent Claims 1, 6, and 44 were rejected as being anticipated by Popov. Claims 1, 6, and 44 each relate to a surgical access port for insertion into a body cavity, comprising, among other recitations, “an elongate tubular body” and a “tip” or “tissue penetrating tip” for penetrating through a body wall and into the body cavity. The tip or tissue penetrating tip has a “first, penetrating position extending axially distally of the distal end of the tubular body.” For at least the reasons previously discussed in greater detail in the Response filed August 5, 2009 and the Appeal Brief filed April 5, 2010 in the present Application, Applicant believes the lid 31 (indicated in the Office Action to correspond to the recited tissue penetrating tip) of the Popov needle tip protection system to be incapable of penetrating tissue. However, in order to expedite prosecution on the claimed subject matter, Applicant has amended the independent

claims herein to further structurally distinguish the tissue penetrating tip recited herein from the applied art.

As previously discussed, Popov does not disclose or suggest that the lid 31 is sharp pointed or bladed, or is capable of penetrating through a body wall. FIGS. 8 and 9 of Popov are reproduced below.

Moreover, comparing FIGS. 8 and 9, in the configuration illustrated in FIG. 9, the lid 31 is *recessed within the end of the handle 8*. Thus, Popov fails to disclose or suggest that the lid has a penetrating position “extending axially distally” of a distal end of the handle 8, as recited with respect to the tip and the elongate tubular body in Claims 1, 6, and 44. On the contrary, Popov emphasizes the perceived advantages of having reduced device length in the “protection position” (indicated to be FIG. 9). (Popov, col. 1, lines 38-40, 48-50; col. 4, lines 10-12).



Accordingly, for at least the reasons previously discussed during prosecution of the present Application and those presented above, independent Claims 1, 6, and 44 are distinguishable over the applied art. Claims 4, 8-13, 25-26, and 40-43 each depend from one of independent Claims 1 and 6. Accordingly, Claims 4, 8-13, 25-26, and 40-43 are likewise distinguishable over the applied art for at least the reasons discussed above with respect to Claims 1 and 6.

**Popov and the Applied Combination of Popov and Roth Fail to Disclose or Suggest the Subject Matter Recited in Claims 2, 3, and 16.**

Curiously, in paragraph 12, Office Action indicates that arguments against the combination of Popov and Roth are "now moot due to withdrawal of the 103(a) rejection." However, as noted above, Claims 2 and 3 were rejected as unpatentable over Popov in view of Roth. The Examiner relies on Roth only for disclosing a port with an opening sealed by a seal housing and variations of tips. Claims 2 and 3 are dependent on Claim 1. As discussed above, Popov does not disclose or suggest every feature recited in Claim 1. Consequently, for at least the reasons discussed above Popov and Roth do not disclose or suggest every feature recited in Claims 2, 3.

Moreover, for at least the reasons previously discussed in greater detail, one skilled in the art would be dissuaded from combining Popov with Roth as suggested in the Office Action. As previously discussed in previous prosecution on the present Application, including at least the Appeal Brief filed April 5, 2010, one of ordinary skill in the art would be dissuaded from making the combination of Popov, which relates to an apparatus that avoids unintentional or inadvertent pricks, cuts, or other tissue damage with the exposed tissue penetrating feature of Roth as doing so would render the Popov device unsuitable for its intended purpose. Additionally, as previously discussed, because the proximal end of the handle 8 of the Popov device is closed by proximal lid 27, one skilled in the art would not operably connect a seal housing to the proximal end of the handle 8. Furthermore, the open longitudinal slot 29 formed in the handle 8 of the Popov device allows venting between the cavity 32 of the handle 8 and ambient conditions, rendering a seal housing disposed at the proximal end of the handle 8 completely inoperable.

Accordingly, for at least the reasons discussed above, Claims 2 and 3 are distinguishable over the applied combination of references.

Claim 16 stands rejected under rejected under 35 U.S.C. § 103(a) as unpatentable over Popov. Claim 16 is dependent on Claim 1. Because Claim 1 is distinguishable over Popov, as discussed above, Claim 16 is also distinguishable for at least the same reasons.

### **Conclusion**

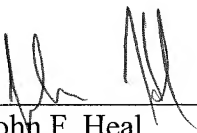
For at least the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, issuance of a Notice of Allowability is most earnestly solicited.

Applicant respectfully traverses each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches. Although amendments have been made, no acquiescence or estoppel is or should be implied thereby. Any arguments in support of patentability and based on a portion of a claim should not be taken as founding patentability solely on the portion in question; rather, it is the combination of features or acts recited in a claim which distinguishes it over the prior art.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney, John F. Heal, at (949) 713-8283 to resolve such issues promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 01-2215.

Respectfully submitted,  
APPLIED MEDICAL RESOURCES

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